



UNITED STATES DEPARTMENT OF COMMERCE  
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AUG 26 1996

Paper No. 10

In re Application of  
Stan Hockerson  
Serial No. 08/400,336  
Filed: March 8, 1995  
For: INDEPENDENT IMPACT  
SUSPENSION ATHLETIC  
SHOE

:  
: DECISION ON PETITION  
: REGARDING FINAL ACTION  
:  
:

Applicant's petition, filed on August 13, 1996, requests supervisory review of the examiner's holding that the Office letter dated April 26, 1996 should be a final action, and of the propriety of the examiner's refusal to enter the amendment and 37 CFR § 1.132 declaration filed on July 26, 1996.

The petition is GRANTED-IN-PART.

The petition alleges that the examiner abused his discretion in making the Office letter dated April 26, 1996 final by acting contrary to the direction set forth in MPEP 706.07(a). Specifically, the petition alleges that whereas a newly cited reference was used in the final action in response to amendments introduced by the amendment dated March 18, 1996, the final action also relied upon a new reference which was not itself necessitated by the March 18, 1996 amendment. It is argued, therefore, that MPEP § 706.07(a) precludes making the April 26, 1996 action final. It is further argued that it was, therefore, improper to refuse to enter the amendment and the declaration filed on July 26, 1996 because those papers should not have been tested under 37 CFR § 1.116 which governs only amendments after final action. The petition also relies upon MPEP § 715.09 for the proposition that the declaration should have been considered to be timely filed, even assuming that the April 26, 1996 Office letter was properly made final.

A review of the record shows that although the petition alleges that "the only substantive amendment to the claims in applicant's first Amendment and Response to Office Actions was to add the limitation of the lasting board...", claim one was in fact amended with regard to the previously claimed "longitudinal channel". Prior to amendment, claim one was broad enough to read on a shoe having more than one channel therein. The examiner's action proposed adding one or more of the longitudinal channels that were taught in the Ellis reference to the structure of the Hunt reference, which possessed transverse channels. Claim one as amended on March 18, 1996, required that the channel longitudinal channel in the bottom surface of the sole extend through the peripheral rim and that this same channel divide the heel portion into adjacent compression elements. Interestingly, this point was argued by applicant

in the amendment. To the extent that the examiner took the position that the change in the manner of reciting the structure of the longitudinal groove necessitated the application of a new reference, the examiner's action clearly complies with the mandate of MPEP § 706.07(a). Moreover, even if the sole change to claim one had been the addition of the lasting board limitation, to the extent that citation of a new reference for this previously unclaimed feature might have necessitated the use of another newly applied reference having teachings more compatible with the newly cited "lasting board" reference, the use of that newly applied reference would not have precluded making the Office letter in question final under MPEP § 706.07(a).

As the examiner's action in making the Office letter in question final was neither arbitrary nor capricious, nor an abuse of discretion, it follows that the examiner's application of 37 CFR § 1.116 to exclude the amendment dated July 26, 1996 from entry into the record because it raised new issues requiring further consideration and/or search was also within the examiner's clear discretion. However, it does appear that the examiner erred in excluding the declaration filed on July 26, 1996 from consideration. While this declaration is clearly filed under 37 CFR § 1.132 and not under 37 CFR 1.131, and, therefore, applicant's arguments directed to MPEP § 715.09 are not technically relevant, it appears from the record that these arguments were made in response to the examiner's citation of MPEP § 715.09 (which sets forth the criteria for timeliness of declarations filed under 37 CFR 1.131) in the advisory action dated August 2, 1996. The criteria governing timeliness of 37 CFR § 1.132 declarations are listed in MPEP § 716.01. Here, it appears that these criteria are in fact satisfied, since the declaration in question was in fact submitted with applicant's first response to a final action for the purpose of overcoming a grounds of rejection first set forth in the final action.

Accordingly, this application is being returned to the examiner. The examiner is directed to consider the merits of the declaration filed on July 26, 1996. The examiner is further instructed to communicate his findings thereon telephonically to applicant, so that applicant may be informed thereof in the most expeditious fashion. The examiner will then prepare a supplemental advisory action containing those findings for mailing to applicant. The period for response to the final action dated April 26, 1996 continues to run as set therein.

PETITION GRANTED-IN-PART.



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A message about the <sup>suppl.</sup> advisory action was left for Applicant on 8/3/96 SK.